

REMARKS

Claims 1, 4-10, 13 and 14 are pending in the instant application. Claims 1, 4-10, 13 and 14 stand rejected. Claims 1, 4-10, 13 and 14 stand rejected under 35 U.S.C. §112, first paragraph for lacking enablement. Claims 1, 4-10, 13 and 14 stand rejected under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. Claims 1, 4-10, 13 and 14 stand rejected under stand rejected under 35 U.S.C. §103 as being unpatentable in view of United States Patent No. 4,994,013 to Suthanthiran et al. In order to expedite prosecution, Claims 1 and 8 have been amended and claim 7 has been canceled. None of the amendments constitute new matter in contravention of the requirements of 35 U.S.C. §132. Reconsideration is respectfully requested.

112 First Paragraph Rejection

Claims 1, 4-10, 13 and 14 stand rejected under 35 U.S.C. §112, first paragraph for lacking enablement. In order to expedite prosecution, Applicants have amended claims 1 and 8 and have withdrawn claim 7. Accordingly, this rejection is respectfully traversed.

The Examiner contends that the specification does not reasonably provide enablement for all substrates and iodine containing compounds. Applicants respectfully submit that claims 1 and 8 as currently amended are limited to those substrates which are substantially non-radiation attenuating and the iodine containing compounds disclosed in examples 1-5, pages 18-21 of the specification. As claims 1 and 8 have been amended to more particularly recite the scope of the present invention, Applicants respectfully submit

that the present claims are enabled. Reconsideration and withdrawal of the rejection are respectfully requested.

112 Second Paragraph Rejection

Claims 1, 4-10, 13 and 14 stand rejected under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants have amended claims 1 and 8 and have withdrawn claim 7 to point out and distinctly claim the subject matter of the invention. Accordingly, this rejection is respectfully traversed.

The Examiner states that “an intended use clause found in the preamble of a product claim is not afforded the effect of a distinguishing limitation wherein the product is a self-contained descript of the structure (i.e. product) not depending on the preamble for completeness.” Accordingly, Applicants amended claim 1 by excluding claim language “suitable for use in brachytherapy”.

It is important to point out, though, that the present invention is directed to a radioactive source for brachytherapy and it is this source which includes an iodine or iodide ions that is adsorbed onto a non-radiation attenuating substrate.

Furthermore, in the Office Action dated November 30, 2004, the Examiner objects to claim 13 for reading on the “treatment of any possible condition, which is responsive to radiation therapy. (emphasis Examiner’s). Applicants submit that claim 13

is fully proper according to 35 U.S.C. §112, second paragraph. Applicants submit that by limiting the method of treatment to a condition which is responsive to radiation therapy, that the claim is well defined. The Examiner's emphasis on "any possible condition" in the cited excerpt from the rejection chooses to ignore the limitation that the condition must be responsive to radiation therapy. As the Applicants have defined within the claim the conditions which are included within the claim scope, it is incorrect to state that the claim is directed to "any possible condition" as the Examiner does in ending further inquiry. As claim 13 fully defines the conditions to which it applies, it is respectfully submitted that such claim structure is fully within the bounds of 35 U.S.C. §112, second paragraph.

As the Examiner's objection to both claims 1 and 13 have been traversed, Applicants respectfully request that the rejection under U.S.C. §112, second paragraph be withdrawn. Reconsideration is respectfully requested.

103 Rejection

Claims 1, 4-10, 13 and 14 stand rejected under 35 U.S.C. §103 as being unpatentable in view of United States Patent No. 4,994,013 to Suthanthiran et al. This rejection is respectfully traversed.

In maintaining the rejection the Examiner again states that patentability is based upon the components of the product, not what each component does.

The present invention is directed to a radioactive source for brachytherapy which includes a radioactive isotope of iodine or iodide ions adsorbed onto a non-radiation attenuating substrate.

Suthanthiran discloses a metallic X-ray detectable marker rod coated with a radioactive-absorbing material in a binder into which a radioactive material is absorbed.

Suthanthiran only discloses that the radioactive material is absorbed by radioactive-absorbing material used to coat the substrate/rod. Suthanthiran fails to disclose, teach, or suggest that the radioactive material is adsorbed onto a substrate as is claimed by the present invention. Applicants further submit that as Suthanthiran requires its marker rod be coated with a radioactive-absorbing material, to suggest that the radioactive-absorbing material was not necessary would require impermissibly ignoring the specific teachings of the reference. Applicants respectfully submit that Suthanthiran provides no motivation for adsorbing a radioisotope to the surface of a substrate itself. Suthanthiran fails to disclose, teach, or suggest a radioactive material adsorbed on the surface of a non-radiation attenuating substrate.

Furthermore, Suthanthiran discloses that a pellet is encapsulated by a titanium container or another material other than titanium, column 5, lines 13-26. Suthanthiran does not teach, suggest, or is motivated to encapsulate the pellet with a biocompatible container as claimed in the present invention. To equate a container made with material other than titanium with a biocompatible container is a far-reaching comparison.

Additionally, to support a case for obviousness, the proper test is whether the reference, taken as a whole, would suggest the invention to one of ordinary skill in the art. Milliken Research Corp. v. Dan River, Inc., 222 U.S.P.Q 571 (Fed. Cir. 1984). Accordingly, it is respectfully submitted that the Examiner has been unable to show that Suthanthiran, taken as a whole, would suggest the present invention to one of ordinary skill in the art.

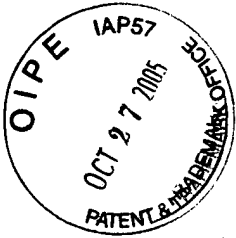
Therefore, Applicants respectfully submit that the present invention is patentably distinct from Suthanthiran. Reconsideration and withdrawal of the rejection are respectfully requested.

In view of the amendments and remarks hereinabove, Applicants respectfully submit that the instant invention, including claims 1, 4-6, 8-10, 13 and 14, are patentably distinct over the prior art. Favorable action thereon is respectfully requested.

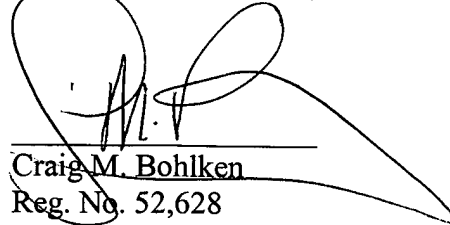
This application is being filed within two-months from the date of mailing of the Office Action in order to obtain an Advisory Action on said application. Furthermore, a fee is not required in connection with the filing of this amendment. However, if any fee is required, the Commissioner is authorized to charge such fee to Deposit Account No. 502-665.

Appl. No. 10/009,576
Amdt. Dated October 25, 2005
Reply to Office action of August 25, 2005

Any questions with respect to the foregoing may be directed to Applicants'
undersigned agent at the telephone number below.



Respectfully submitted,



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